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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/617,065 | 07/13/2000 | Norman Understein | 2802-5 | 7218 |
| 23117 | 7590 | 01/12/2006 | EXAMINER | |
| NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203 | | | COLBERT, ELLA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3624 | |

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/617,065 | Applicant(s) UNDERSTEIN, NORMAN | |
| | Examiner Ella Colbert | Art Unit 3624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-9 are pending in this communication filed 10/28/05 entered as Appeal Brief Filed.

Reopening Prosecution After Filing of Appeal Brief

2. In view of the Appeal Brief filed on 10/28/05, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth here below.

To avoid abandonment of the application, Appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office Action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellants' must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing at the end of this Office Action.

3. The previous Non-Final Office Action is hereby withdrawn in view of the new ground(s) of rejection.

Claim Objections

4. Claim 1 (b), 7, 8, and 9 (a) are objected to because of the following informalities: Claim 1 (b) recites "... from the participant to an other party". This claim limitation would

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be better recited as "... from the participant to another party". Claims 7, 8 (preamble), and claim 9 (a) have a similar problem. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 (b) recites the limitation "participant to an other party" in line 8, page 18.

Claim 7 in the preamble recites the limitation "participant to an other party, the computer system comprising:". Claim 8, page 20, line 5 recites the limitation "the participant to an other party". Claim 9(a), page 20, line 5 recites "participant to an other party". There is insufficient antecedent basis for this limitation in the claim.

Claims 7 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7, lines 7-11, page 19, "Claims Appendix" recites "... the system server determining whether the participant has established a consumer funding account by depositing funds in the consumer funding account, and if so". It is vague and unclear what Applicant means by "and if so"? Does Applicant mean "the system server has determined the participant has established a consumer funding account by depositing funds in the consumer funding account"? This portion of the claim limitation is missing making the claim limitation incomplete and unclear. Claim 9(b) has a similar problem with the "wherein if not". Clarification in the claim language is respectfully requested.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,493,683) David et al, hereafter David.

As per claim 1, David teaches, A method of qualifying a participant over a global network in a transaction requiring a transfer of funds from the participant using a qualifying system, the method comprising: (a) the participant establishing a consumer funding account by depositing funds in the consumer funding account, the consumer funding account to be administered by the qualifying system (col. 4, lines 43-51 –“prior to any trading, each customer may be required to register with the server and with a custodian. As part of this registration, the customer gets an identification and password for the system. The customer must also deposit with the custodian his commodities.”); (b) the participant entering a transaction requiring a transfer of funds from the

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participant to another party (col. 4, lines 51-54- "The customer must deposit with the custodian his commodities. Before he can buy any commodities, a customer must also register with a custodian and either deposit funds or other assets or provide sufficient information to receive a credit rating for a particular amount."); (c) the qualifying system reserving a portion of the consumer funding account according to a transaction parameter determined by at least one of the qualifying system the participant or the other party (col. 4 lines 48-51) and (d) the qualifying system qualifying the participant for the transaction if the consumer funding account satisfies conditions of the transaction parameter (col. 4, line 58-65). David did not expressly disclose the system as a qualifying system. However, David does disclose "a registration process with the server and with a custodian. As part of this registration, the customer gets an identification and password for the system. The customer must also deposit with the custodian his commodities before he can buy and commodities, a customer also must register with a custodian and either deposit funds or other assets or provide sufficient information to receive a credit rating for a particular amount." It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a qualifying system and to modify in David because such a modification would allow David's system to have a qualification process to include the deposit of funds or other assets with a custodian prior to any trade by the customer with the server receiving a confirmation through the custodian that the customer has the right to sell and that the customer has deposited sufficient assets to purchase the funds.

As per claim 2, David teaches, A method according to claim 1, wherein the transaction parameter is a required deposit (col. 5, line 63-col. 6, line 5).

As per claim 3, David teaches, A method according to claim 1, wherein the transaction parameter is an amount of funds required to complete the transaction (col. 7, lines 23-35).

As per claim 4, David teaches, A method according to claim 1, wherein step (c) is practiced by reserving a first portion of the consumer funding account corresponding to a required deposit and reserving a second portion of the consumer funding account corresponding to an amount of funds required to complete the transaction (col. 7, lines 45-65).

As per claim 5, David teaches, A method according to claim 1, further comprising releasing the reserved portion of the consumer funding account when the transaction is completed (col. 7, lines 56-65 and col. 8, lines 25-35).

As per claim 6, David failed to teach, A method according to claim 1, wherein step (c) is practiced by querying a network website server that maintains the consumer funding account. It would have been obvious to one having ordinary skill in the art at the time the invention was made to query a network website server that maintains the consumer funding account and to modify in David because such a modification would allow David's system to have a website on the Internet that is accessible to consumers with the ability to browse (query) the different commodities.

As per claim 7, David teaches, A computer system for effecting qualifying of a participant over a global network in a transaction requiring a transfer of funds from the participant to an other party, the computer system comprising:
at least one user computer running a computer program that requests information according to a transaction inquiry input by the participant (col. 5, lines 25-35 and line 63- col. 6, line 13); and a system server running a server program (col. 4, lines 18-42), the at least one user computer and the system server being interconnected by a computer network (col. 4, lines 43-47), the system server determining whether the participant has established a consumer funding account by depositing funds in the consumer funding account (col. 4, lines 48-51 and lines 54-65), and if so, the system server reserving a portion of the consumer funding account according to a transaction parameter determined by at least one of the system server, the participant or the other party (col. 4, lines 54-58) wherein the system server administers the consumer funding account (col. 4, lines 58-63) and wherein the system server qualifies the participant for the transaction if the consumer funding account satisfies conditions of the transaction parameter (col. 4, lines 58-65). This independent claim is also rejected for the similar rationale as given above for claim 1.

As per claim 8, David did not teach a computer program embodied on a computer-readable medium. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a computer program embodied on a computer-readable medium and to modify in David because such a modification would allow David to have the ability to implement a method and system for qualifying a

participant with steps corresponding to the method and system steps of claims 1 and 7. This independent claim is rejected for the similar rationale as given above for claims 1 and 7.

As per claim 9, David further teaches, (b) the qualifying system determining whether the participant has established a consumer funding account, wherein if not, the qualifying system providing the participant an opportunity to establish the consumer funding account, the consumer funding account to be administered by the qualifying system (col. 2, line 64-col. 3, line 6 and line 55-col. 4, line 13, and lines 43-51) and after establishing the consumer funding account, the qualifying system continuing with the transaction (col. 4, lines 54-65). This independent claim is rejected for the similar rationale as given above for claims 1 and 7.

Response to Arguments

10. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Abecassis (US 5,426,281) disclosed a purchaser communicating his purchase to a purchasing center and the order being loaded into a purchasing system program. Funds are then sent to the purchasing center which, after verifying the order and the

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receipt of the funds, sends the funds and an instruction to pay an escrow agent (col. 2, lines 2-25).

Inquiries

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
Primary Examiner
January 9, 2006



Vincent Millin
Supervisory Patent Examiner (SPE)

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